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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of :
Ulrich Klar et al. : Group Art Unit: 1625
Serial No.: 09/485,292 : Examiner: C. C. Chang
Filed: 3 May 2000 :

For: NEW EPOTHIOLONE DERIVATIVES, PROCESS FOR THEIR PRODUCTION, AND
THEIR PHARMACEUTICAL USE

PETITION UNDER 37 C.F.R. §1.182

Group Director
TECHNOLOGY CENTER 1600
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a petition requesting the Commissioner, through the Group Director, to withdraw the Examiner's Office Action dated 26 July 2007.

Statement of Facts

On 23 February 2007, Applicants' filed an appeal brief. The brief contains a statement of the status of all the claims. The status of claims listed in the appeal brief is identical to the disposition of the claims set forth by the Examiner in the Office Action dated 14 September 2006. Applicants' brief was fully compliant with the rules set forth in 37 CFR 41.37(c). The brief is directed only to properly appealable issues.

On 26 July 2007 the Examiner sent out an Office Action stating that the brief filed on February 23, 2007 is unacceptable because the claims contain subject matter, which is not appealable. The action stated the appeal would be dismissed unless applicants amended the claims to the elected invention.

Although not believed to be relevant to the issues for review here, for completeness, the following facts regarding the restriction requirement are provided. On 2 June 2002 Applicants

fully responded to the Office Action making a restriction requirement and requesting an Election of Species. The claims subject to the original restriction, claims 13-30 are now canceled. The response included a request that the remainder of the claims be examined in accordance with MPEP 803.02. The claims here are Markush claims. MPEP §803, entitled "Restriction - When Proper," states that "insofar as the criteria for restriction practice relating to Markush-type claims is concerned, the criteria are set forth in MPEP §803.02.

In the following Office Action, the Examiner changed the Election to a Restriction, creating groups that included options that were not even present within the claims (i.e., requesting that individual Markush group members be narrowed). Applicants' objection to this position was previously stated on the record i.e., the claims should be examined in accordance with MPEP 803.02. The claims on appeal include the full scope of the Markush claim, which includes elected and non-elected subject matter.

Points to be reviewed

1. Does the Examiner have the authority to dismiss an appeal?
2. Is the appeal dismissible under the instant facts?

Arguments

As to point 1, applicants can find no authority for an Examiner to dismiss an appeal. The Examiner does not rely on any statute, rule, judicial decision, or section of the MPEP to support her authority to dismiss an appeal.


As to point 2, the Examiner also provides no basis, and none is evident, to support the contention that the claims must be amended to limit them to the elected invention before the brief is sent to the Board of Appeals. To the contrary, the rules on Appeal Briefs expressly call for identifying claims that are "withdrawn" due to restriction or election of species but remain in the application. Determination of the appealable issues can be made despite "withdrawn" subject matter present in the claims. Although applicants maintain that the claims are proper Markush claims and should not be subject to restriction, that is not relevant here, because the claims on appeal may contain withdrawn subject matter, whether due to restriction or election of species practice.

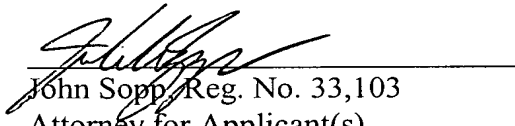
Action Requested

For the forgoing reasons, Applicants respectfully request the Group Director withdraw the Office Action of 26 July 2007. Furthermore, Applicants respectfully request the Group Director to direct the Examiner to provide an Examiner's Answer or conduct and/or conduct an appeal conference in accordance with 37 CFR 41.39.

The Commissioner is hereby authorized to charge the petition fee under 37 CFR §1.17(f) and any other fees associated with this response or credit any overpayment to Deposit Account No. 13-3402. However, in view of what is believed to be the clear impropriety of the Examiner's actions here, it is urged that no fee be charged or that the fee be refunded after charge.

Respectfully submitted,


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Attorney Docket No.: **SCH-1742**

Date: **31 July 2007**

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